



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,649	01/27/2004	Younger Ahluwalia	03137.000006	4007
5514 7590 09/05/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
09/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

NOTE

1. Applicants' remarks filed on 7/29/2008 have been entered. Applicants' request to rejoin claim 8 is acknowledged. However, since claim 8 is structurally distinct from claim 7, it has been previously withdrawn as non-elected. Claims 1, 7, 13 and 16-20 are active.

2. Applicants argue at Remarks pages 7-8 that

"there is no suggestion or motivation in any of the cited references to alter Lynn et al. to produce a composite material according to the present claims. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

However, the prior art references are of the same field of endeavor, facers, combining the desirable features for improvement over their beneficial effects are clearly obvious modification to one of ordinary skill in the art.

Applicants argue at page 8 that

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."

However, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicants argue at pages 9-10 that

"Lynn et al. does not indicate that the conventional foam facers can be modified by additives, but rather the polymeric facers of the invention can be modified by additives. Furthermore, Applicants note that the facers of Lynn et al. are characterized as films at col. 3, line 28. Lynn et al. further teach that the total thickness of the insulation boards is

Art Unit: 1794

about 0.5 inches (- 12.7 mils to about 4.25 inches (-106 mils), of which the thickness of the facing sheets is generally 0.3 mils to 5 mils, with monolayer facers being preferably about 0.3 mils to 3 mils and composite facers being preferably about 0.3 mils to 4 mils. Col. 5, lines 34-41.”

However, the grounds of rejection are collective teachings of the prior art references, applicants' argument directed to Lynn individually is misplaced. There is nothing whatsoever Lynn's teaching prevents one of ordinary skill in the art to combine the teachings of prior art and renders the claimed invention obvious. Further, applicants are respectfully reminded that the thickness of the facer are absent from the claimed limitations. Even if they are recited, since the collective teachings of prior art render the structure and combination obvious, a workable thickness is deemed to be obvious routine optimization to one of ordinary skill in the art, dictated by the same end use as the claimed invention.